

and including at least one intake opening for receiving the incoming fluid and at least one outlet opening for returning the outgoing fluid.--

REMARKS

I. Request For An Interference With Martin

Applicants have added new claims 19-38. Thus, claims 1 and 19-38 are pending and are presented for purposes of an interference with U.S. Patent No. 5,156,592 to Martin et al. which issued on October 20, 1992 and is directed to a "Pre-Curved Dual Lumen Catheter (hereinafter "Martin", a copy of which is attached as Exhibit A)."

The claims in the Martin patent are directed to the same patentable invention as the claims of the present application. Specifically, new claim 19 is identical to Martin claim 1 and new claims 20-38 are substantially the same as Martin claims 1-19. Therefore, applicants' claims 1 and 19-38 are presented expressly for purposes of an interference with the Martin patent.

II. Applicants' Effective Filing Date Antedates The U.S. Filing Date Of The Martin Patent And The Foreign Filing Date Of The Martin Patent

The present application is a continuation of U.S. application Serial No. 08/045,016, which is a continuation-in-part of U.S. application Serial No. 772,613 filed October 8, 1991, now U.S. Patent No. 5,209,723. The '613 application, in turn, is a continuation of application Serial No. 461,684, filed January 8, 1990, abandoned.

This application contains the disclosure of each of the prior applications. Further, the pending claims are fully supported by the disclosure in the original '684 application filed January 8, 1990.^{1/} Thus, the effective priority date of the present application is January 8, 1990, which is about one year and three months prior to the April 4, 1991 U.S. filing date of the Martin patent.

Applicants need only antedate the U.S. filing date of Martin to establish that an interference is appropriate. See MPEP 2308.01; In re Hilmer, 359 F.2d 859, 149 U.S.P.Q. 480 (CCPA 1966). However, it is evident that applicants also antedate the April 4, 1990 foreign filing date of Martin, since applicants' original U.S. application Ser. No. 461,684 was filed about three months prior to the Martin Canadian application.

Because applicants' effective filing date is before the U.S. filing date of the Martin patent, no showing pursuant to 37 C.F.R. § 1.608 is required. Also, applicants' claim 1 was present in application Ser. No. 045,016 as originally filed on April 8, 1993. Thus, claim 1 was presented within one year of the October 20,

^{1/} Attached as Exhibit B, for the Examiner's convenience, is a claim chart showing in column form (1) the Martin issued claims, (2) applicants' pending claims, (3) location in applicants' present specification where support is found for applicants' claims 1 and 19-38, (4) location in applicants' parent case filed January 8, 1990 as U.S. Appln. Ser. No. 461,684 where support is found for applicants' claims 1 and 19-38. In column 4 of Exhibit B, reference is made to U.S. Patent No. 5,209,723 (attached as Exhibit C), which issued on a continuation of U.S. Ser. No. 461,684, for convenience of citation. The specification of the '723 patent differs from that of the as-filed '684 application only in minor respects, such as a modification to the description of Fig. 1A under the "Description of Drawings" and the inclusion of a cross reference to the earlier filed application upon the filing of a continuation.

1992 issue date of the Martin patent, and is directed to substantially the same subject matter as claim 1 of the Martin patent, in accordance with 35 U.S.C. § 135(b).

As further pointed out below, an interference between Martin and this application is appropriate.

III. The Newly Presented Claims Are Directed To Patentable Subject Matter

Applicants' claim 19 is identical to claim 1 of Martin. Applicants' claims 1 and 20-38 are very similar to claims 1-19 of the Martin patent. Because the claims of the Martin patent have been found to be patentable, applicants' claims, one of which is identical to Martin claim 1 and the others of which are substantially the same as the Martin claims, must be directed to patentable subject matter. The reasons for allowance of the Martin claims ipso facto apply equally to applicants' claims.

IV. The Newly Presented Claims Are Supported By Applicants' Specification And The Disclosures From Which Applicants Claim Priority

Applicants' newly presented claim 19 is identical to claim 1 of Martin. Newly presented claims 20-38 are very similar to, but not exactly the same as, the claims in the Martin patent. Some of the claims copied from the Martin patent have been slightly modified to correct certain form and antecedent basis problems. The table attached as Exhibit B provides a comparison of Martin claims 1-19 and applicants' claims 1 and 19-38.

The attached table also shows the respective support for applicants' claims in this application and in U.S. Patent No.

5,209,723, from which this application claims priority of the original January 8, 1990 filing date.

V. An Interference Between The Present Application And The Martin Patent Is Appropriate

As is apparent from the attached table, applicants' claims 1 and 19-38 substantially correspond to Martin claims 1-19. Because, e.g., applicants' claim 19 is the same as Martin claim 1, it is clear that the parties are claiming common patentable subject matter and thus an interference is appropriate.

Although applicants' claims 1 and 38 are slightly broader than the corresponding claims of the patentee, this is of no significance with regard to the propriety of initiating the requested interference. As stated in 37 C.F.R. § 1.601(i):

An interference may be declared between one or more pending applications and one or more unexpired patents naming different inventors when, in the opinion of an Examiner, any application and any unexpired patent contain claims for the same patentable invention.²⁷

The test for ascertaining if claims are directed to the same patentable invention is set forth in 37 C.F.R. § 1.601(n):

Invention "A" is the "same patentable invention" as an invention "B" when invention "A" is the same as (35 U.S.C. § 102) or is obvious (35 U.S.C. § 103) in view of invention

²⁷ Note also M.P.E.P. § 2306 which provides in pertinent part:

The requirement that claims of the application and that of the patent define the same patentable invention in order for an interference to exist does not mean that the application claim or claims must necessarily be identical to the corresponding claim or claims of the patent. All that is required under present practice is that a claim of the application be drawn to the same patentable invention as a claim of the patent.

"B" assuming invention "B" is prior art with respect to invention "A".

Under the test set forth above, invention "A" (e.g., applicants' claim 1) is directed to the "same patentable invention" as invention "B" (e.g., Martin claim 1) because, assuming invention "B" is prior art with respect to invention "A", invention "B" anticipates invention "A" within the meaning of 35 U.S.C. § 102. Invention "B" anticipates invention "A" because Martin claim 1 falls within applicants' claim 1.

VI. Proposed Structure For The Requested Interference

The broadest claim in the Martin patent is claim 1. Applicants' broadest claim, claim 1, is broader in certain respects than claim 1 of Martin. Therefore, a Proposed Count, as required by 37 C.F.R. § 1.607, is applicants' claim 1:

A catheter for hemodialysis which comprises a flexible catheter tube defining a plurality of separate lumens, said catheter defining an arc angle of generally U-shape in its natural, unstressed configuration, whereby said catheter may be implanted with a distal catheter portion residing in a vein of a patient, said distal catheter portion being of substantially the shape of said vein in its natural unstressed condition, and a proximal catheter portion residing in a surgically created tunnel extending from said vein and through the skin of the patient, whereby blood may be removed from said vein through one lumen of the catheter and blood may be returned to said vein through another lumen of the catheter.

Applicants' claim 38, which is broader than Martin claim 1, is submitted as an alternative Proposed Count. Claim 38 is substantially the same as Martin claim 1, except the limitation regarding a septum defining two D-shaped lumens is omitted. Dual lumen catheters having D-shaped lumens are well-known in the art;

therefore, this feature alone does not impart patentability to the claim. Applicants' claim 38 of the present application reads:

A flexible catheter for prolonged vascular access, the catheter comprising: an elongate flexible and tubular body having a proximal portion, a distal portion and a permanently curved portion linking the proximal and distal portions so that the curved, the proximal and the distal portions lie naturally in essentially the same plane with the angle contained between the proximal and distal portions being less than 90°; intake and outlet tubes coupled to the proximal portion at a proximal end of the body remote from the curved portion to receive incoming fluid from the intake lumen and to supply outgoing fluid to the outlet lumen; and a tip formed on the distal end of the distal portion and including at least one intake opening for receiving the incoming fluid and at least one outlet opening for returning the outgoing fluid.

A third proposal is an "alternative" count, which would permit each of the parties the benefit of having a count that uses their own words. Such a count would include both applicants' claim 1 and Martin claim 1 (without the septum limitation) separated by an "or". It would read as follows:

A catheter for hemodialysis which comprises a flexible catheter tube defining a plurality of separate lumens, said catheter defining an arc angle of generally U-shape in its natural, unstressed configuration, whereby said catheter may be implanted with a distal catheter portion residing in a vein of a patient, said distal catheter portion being of substantially the shape of said vein in its natural unstressed condition, and a proximal catheter portion residing in a surgically created tunnel extending from said vein and through the skin of the patient, whereby blood may be removed from said vein through one lumen of the catheter and blood may be returned to said vein through another lumen of the catheter.

"or"

A flexible catheter for prolonged vascular access, the catheter comprising: an elongate flexible and tubular body having a proximal portion, a distal portion and a permanently curved portion linking the proximal and distal portions so that the curved, the proximal and the distal portions lie naturally in essentially the

same plane with the angle contained between the proximal and distal portions being less than 90°; intake and outlet tubes coupled to the proximal portion at a proximal end of the body remote from the curved portion to receive incoming fluid from the intake lumen and to supply outgoing fluid to the outlet lumen; and a tip formed on the distal end of the distal portion and including at least one intake opening for receiving the incoming fluid and at least one outlet opening for returning the outgoing fluid.

In structuring the interference, all claims in the involved cases which are directed to patentably indistinct subject matter should be designated as corresponding to the count. Thus, Martin claims 1-19 and applicants' claims 1 and 19-38 should all be designated as corresponding to the count.

VII. Benefit Of Earlier U.S. Application Should Be Accorded To Applicants When Declaring The Interference

As described above and shown in Exhibit B, applicants have established that they are entitled to the benefit of their earlier-filed U.S. parent application, U.S. Ser. No. 461,684 filed January 8, 1990. Such benefit should be accorded in declaring the interference and applicants should be designated as senior party in the interference. Martin, whose U.S. filing date is April 4, 1991, should be designated as the junior party.

Further, unless Martin has inventive activity in the U.S. upon which it can rely, the earliest date of invention that Martin can establish under applicable U.S. law is its foreign priority date. See 35 U.S.C. § 104(a)(1).^{3/} This date, April 4, 1990, is three months after the U.S. filing date of applicants' U.S. parent

^{3/} See also the effective date provisions with respect to § 104 in the NAFTA Legislation. Public Law 103-182 (Section 335) (December 8, 1993).

application. Thus, when the interference is declared, Martin should be placed under an immediate order to show cause why judgment should not be entered against them.

VIII. Summary And Conclusion

For the foregoing reasons, claims 1 and 19-38 are allowable to applicants. Furthermore, these claims are directed to subject matter that is patentably indistinct from claims 1-19 in the Martin patent. Accordingly, an interference should be declared.

Respectfully submitted,

By:

for

 # 35,876
Barbara Clarke McCurdy
Reg. No. 32,120
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
1300 I Street, N.W.
Washington, D.C. 20005
(202) 408-4000

Date: March 28, 1995

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N.W.
WASHINGTON, DC 20005
202-408-4000